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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/938,290	KOSKELAINEN, PETRI	
	Examiner	Art Unit	
	Stephen M. D'Agosta	2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7-13-04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-30 and 32-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 10-13, 15-21, 23-25, 27-30, 32, 33 and 35-39 is/are rejected.
- 7) ☒ Claim(s) 5, 9, 22, 26 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 7-13-04 have been fully considered but they are not persuasive:

1. The case has been transferred to a new examiner – Stephen D'Agosta.
2. The amendment overcomes the USC 112 rejection.
3. The previous examiner has pointed out objectionable material but the applicant has chosen not to amend the claims with said objectionable material. A more favorable outcome may occur if amending is followed per the examiner's guidelines.
4. The applicant argues that Mukherjee does not teach all features of the claimed invention – eg. Mukherjee data is not service information. The examiner disagrees for several reasons; 1) figure 4 shows mobile user(s) registering via cellular network which inherently includes transfer or service information, 2) figure 6 shows a mobile phone that transfers configuration files #610, network parameters #625 and application data #625, 3) figure 7B shows a configuration file that includes, at least, Registration Duration and Device ID which is service information, 4) figure 10 shows a profile download/return from SMSC #1015/#1020 and 5) Mukherjee's paragraph #35 states that the system is not limited to only that described and one skilled can include any/all service information transfers as needed by the user for ease-of-use.
5. The applicant argues that Mukherjee does not teach requesting service information from a registrar or proxy server. The examiner disagrees and broadly interprets the cellular system's MSC/HLR as a registrar (eg. registering entity). Also, Mukherjee teaches use of TCP/IP and Internet connectivity (figure 2, #228 and #208) which inherently use proxy servers for security.
6. The applicant argues that Holmes-Kinsella does not cure deficiencies regarding having service information provided upon identification. The examiner disagrees for several reasons; 1) Both Mukherjee and Holmes-Kinsella teach

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generic cellular communications which inherently requires mobile device registration whereby service information is only provided upon proper identification (eg. prevents cloning) and 2) Holmes-Kinsella addresses "real-time addition of devices to a subscriber account" (title, abstract) and one skilled would combine Mukherjee and Holmes-Kinsella to ensure that any device failure spawns either automatic or manual addition of a new backup device being registered and put into service. Donovan/Rosenberg follow similar logic and do not use hindsight reasoning.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-8, 18-21, 23-25, 32, 33 and 35-39 are rejected as being anticipated by Mukherjee.

Regarding claim 1, Mukherjee discloses a method comprising storing service information (dynamic presence information) concerning a user (470) in a registrar (presence agent 204) and sending a subscription message (SUBSCRIBE) from a new/recovered terminal (465) to the registrar said service information being information which allows a user to continue their ongoing communication services at a new or recovered terminal (figure 6 shows that data for Work or Home can be stored and would be used to backup the failed device). See Figure 2 and paragraphs 52 and 1 16. A header in the subscription message

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contains a unique indication of a particular user. See paragraphs 7 and 98. The method also comprises, in response to the subscription message containing a unique indication in a header, returning a notification message (NOTIFY) to the user terminal. See paragraph 16. The payload (Message Body) of the notification message includes service information (presence information such as name, status, phone contacts) for the user to be used by the user terminal for communication services (presence applications) See Figure 7A and paragraphs 49.

Regarding claim 2, Mukherjee discloses all of the limitations of claim 1, and also discloses that the user may have a plurality of ongoing communication services at the time that the subscription message is sent. See paragraphs 49 and 50. Regarding claim 3, Mukherjee discloses all of the limitations of claim 2, and also discloses that the payload of the notification message includes service information for each of the ongoing communication services. See paragraphs 49 and 50.

Regarding claim 4, Mukherjee discloses all of the limitations of claim 1, and one of ordinary skill in the art recognizes that the subscription message may be sent after the new/recovered user terminal experiences a failure.

Regarding claim 6, Mukherjee discloses all of the limitations of claim 1, and one of ordinary skill in the art recognizes that the user may switch from a previous terminal to a new or recovered terminal, and that the subscription message may be sent by the new terminal.

Regarding claim 7, Mukherjee discloses all of the limitations of claim 6, and one of ordinary skill in the art recognizes that the new user terminal may be a different type of mobile terminal than the previous terminal.

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Regarding claim 8, Mukherjee discloses all of the limitations of claim 1, and also discloses that the communication services include a push service and the registrar is a push proxy. See paragraphs 49 and 52.

Regarding claim 18, Mukherjee discloses all of the limitations of claim 1, and also discloses that the registrar comprises a SIP registrar, the subscription message comprises a SIP SUBSCRIBE message, the header comprises an event header, and the notification message comprises a SIP NOTIFY response. See paragraphs 85, 97, Page 6, 98, 100, 101 and 117.

Regarding claim 19, Mukherjee discloses all of the limitations of claim 18, and also discloses that the user may have a plurality of ongoing communication services at the time that the SIP SUBSCRIBE message is sent. See paragraphs 49 and 50.

Regarding claim 20, Mukherjee discloses all of the limitations of claim 19, and also discloses that the payload of the SIP NOTIFY response includes service information for each of the ongoing communication services. See paragraphs 49 and 50.

Regarding claim 21, Mukherjee discloses all of the limitations of claim 18, and one of ordinary skill in the art recognizes that the SIP SUBSCRIBE message may be sent after the recovered user terminal experiences a failure.

Regarding claim 23, Mukherjee discloses all of the limitations of claim 18, and one of ordinary skill in the art recognizes that the user may switch from a previous terminal to a new/recovered terminal, and that the SIP SUBSCRIBE message may be sent by the new user terminal.

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Regarding claim 24, Mukherjee discloses all of the limitations of claim 23, and one of ordinary skill in the art recognizes that the new terminal may be a different type of user terminal than the previous user terminal.

Regarding claim 25, Mukherjee discloses all of the limitations of claim 18, and also discloses that the communication services include a push service and the server registrar is a push proxy. See paragraphs 49 and 52.

Regarding claim 32, Mukherjee discloses a mobile terminal. The mobile terminal receives a plurality of communication services (presence applications) and sends a subscription message (SUBSCRIBE) to a registrar (presence agent 204). See Figure 2 and paragraphs 49, 50, 52 and 116 unique identification of a user. A header in the subscription message contains a See paragraphs 97 and 98. The mobile terminal also receives a notification message (NOTIFY) sent from the registrar in response to the subscription message. See paragraph 116. The payload (Message Body) of the notification message includes service information which allows said particular user to continue to receive a plurality of their (presence information such as name, status, phone contacts AND figure 6 shows that data for Work or Home can be stored and would be used to backup the failed device.) communication services at said mobile terminal. See Figure 7A and paragraphs 100, 101, and 115. The mobile terminal uses the service information included in the payload of the notification message to continue the communication services. See paragraphs 49 and 50.

Regarding claim 33, Mukherjee discloses all of the limitations of claim 32, and one of ordinary skill in the art recognizes that the subscription message may be sent after the user terminal experiences a failure.

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Regarding claim 35, Mukherjee discloses all of the limitations of claim 32, and one of ordinary skill in the art recognizes that the user may switch from a previous terminal to the terminal, and that the subscription message may be sent by the terminal.

Regarding claim 36, Mukherjee discloses all of the limitations of claim 32, and also discloses that the subscription message comprises a SIP SUBSCRIBE message, the header comprises an event header, and the notification message comprises a SIP NOTIFY response. See paragraphs 85, 97, 98, 100, 101 and 117.

Regarding claim 37, Mukherjee discloses all of the limitations of claim 1, and also discloses that the unique indication comprises an event name particular to a specific user. See paragraphs 97 and 98.

Regarding claim 38, Mukherjee discloses all of the limitations of claim 1, and also discloses that the unique indication comprises identification of the particular user. See paragraphs 97 and 98.

Regarding claim 39, Mukherjee discloses all of the limitations of claim 32, and also discloses that the unique identification comprises an event name particular to a specific user. See paragraphs 97 and 98.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-13 and 15-17 rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan (UIMPS - Instant Messaging and Presence Using SIP") in view of Holmes-Kinsella (U.S. Patent Application Publication No. 2002/0147000).

Regarding claim 10, Donovan discloses a network architecture comprising a plurality of user terminals and an inherent radio access network. The radio access network inherently contains elements providing information indicating the presence of the terminals. The network architecture also comprises a presence server. The presence server receives the information indicating the presence of the terminals. The network architecture also comprises an inherent communication service provider which provides a plurality of communication services, and a proxy server that allows user communications to continue at a new/recovered user terminal (IMPS architecture, page 4, shows that many client terminals can be used, any could be used as backup if failure occurs by re-registering a user to a new terminal). The proxy server provides the communication services (instant messaging services) to the user terminals upon subscription thereto, stores and maintains service information (presence information) related to the communication services, and provides the service information in a single message (NOTIFY) sent in response to a request (SUBSCRIBE) from a user terminal.

Donovan does not disclose that the proxy server resubscribes the user to ongoing subscription for which service information is stored when the proxy server receives the request from a user terminal.

Holmes-Kinsella discloses a system a method for adding new devices to a user's ongoing subscription. See Abstract. Adding a new device of a user to a user's subscription reads on re-subscribing the user to an ongoing subscription. Holmes-Kinsella's system comprises a service provider which comprises a inherent server. The service provider's server acts as a proxy for information providers. See Figure 1 and paragraph 16. When a user having ongoing subscriptions requests services from the service provider server with a new device, the service provider server re-subscribes the user to the ongoing subscriptions by updating the user's subscriptions to include the new device. See paragraphs 21 and 22. The main benefit of Holmes-Kinsella's invention is that a user may add new devices to the user's pre-existing subscriptions as they are acquired. See paragraphs 6-8. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Donovan with Holmes-Kinsella, such that the proxy server resubscribes the user to ongoing subscription for which service information is stored when the proxy server receives the request from a user terminal, in order to allow the user to add new devices to the user's ongoing subscriptions as they are acquired.

Regarding claim 11, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 10, and Donovan also discloses that the proxy server provides the Page 10 service information in the payload of a notification message (NOTIFY) sent to the requesting new/recovered terminal in response to the request.

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Regarding claim 12, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 11, and Donovan also discloses that the presence server, the proxy server, and the user terminal send message to each other according to SIP and that the notification message comprises a SIP NOTIFY response.

Regarding claim 13, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 12, and Donovan also discloses that the request comprises a SIP SUBSCRIBE message.

Regarding claim 15, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 11. Furthermore, Donovan's user terminal may send the request after it experiences failure (for new/recovered terminal).

Regarding claim 16, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 11. In addition, when a user switches to a new or recovered user terminal from a previous user terminal, the new user terminal may send the request to the proxy server.

Regarding claim 17, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 16, and a new terminal may be a different type of user terminal than a previous user terminal.

Claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg in view of Holmes-Kinsella.

Regarding claim 27, Rosenberg discloses a proxy server which provides a plurality of communication services (instant messaging services) to a plurality of user terminals upon subscription of the user terminals to the communication services, stores and maintains service information (presence information) related to the communication services, and provides the service information in a single

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message (NOTIFY) sent in response to a request (SUBSCRIBE) from a user terminal.

Rosenberg does not disclose that the proxy server resubscribes the user to ongoing subscriptions for which service information is stored when the proxy server receives the request from a user terminal and allows a user to continue their ongoing communication services at a new or recovered user terminal.

Holmes-Kinsella discloses a system a method for adding new devices to a user's ongoing subscription. See Abstract. Adding a new device of a user to a user's subscription reads on re-subscribing the user to an ongoing subscription. Holmes-Kinsella's system comprises a service provider which comprises a inherent server. The service provider's server acts as a proxy for information providers. See Figure 1 and paragraph 16. When a user having ongoing subscriptions requests services from the service provider server with a new devicèe, the service provider server resubscribes the user to the ongoing subscriptions by updating the user's subscriptions to include the new device. See paragraphs 21 and 22. The main benefit of Holmes-Kinsella's invention is that a user may add new devices to the user's pre-existing subscriptions as they are acquired. See paragraphs 6-8.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Rosenberg with Holmes-Kinsella, Page 12 such that the proxy server re-subscribes the user to ongoing subscription for which service information is stored when the proxy server receives the request from a user terminal, in order to allow the user to add new devices to the user's ongoing subscriptions as they are acquired.

Regarding claim 28, Rosenberg in view of Holmes-Kinsella teaches all of the limitations of claim 27, and Rosenberg also discloses that the proxy server provides the service information in the payload of a notification message (NOTIFY) to the requesting new user terminal.

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Regarding claim 29, Rosenberg in view of Holmes-Kinsella teaches all of the limitations of claim 28, and Rosenberg also discloses that the proxy server sends and receives messages according to SIP and that the notification message comprises a SIP NOTIFY response.

Regarding claim 30, Rosenberg in view of Holmes-Kinsella teaches all of the limitations of claim 29, and Rosenberg also discloses that the request comprises a SIP SUBSCRIBE message.

Allowable Subject Matter

Claims 5, 9, 22, 26 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone

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number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta
9-10-04



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